

In re Appln. of BARUCK  
Application No. 10/033,987

### REMARKS

#### *Pending Claims*

Currently pending are claims 1-31. Claims 1-29 are directed to a pointe shoe for ballet dancing including an upper, a lower, and a front and rear sole. Claims 30 and 31 are directed to a method of making a pointe shoe.

#### *Summary of the Office Action*

The Office Action objects to claim 30 as being of improper dependent form under 37 C.F.R. § 1.75(c). The Office Action rejects claims 1-31 under 35 U.S.C. § 103 as obvious over the combination of Dancewear 1999 in view of U.S. 5,035,069 ("Minden '069").

#### *Discussion of the Objections and Rejections*

Applicant respectfully contends that claim 30, which is directed to a method of making the pointe shoe described in claim 1, is a proper dependent claim. For support, Applicant directs the Examiner's attention to M.P.E.P. § 608(n)(III) that states "if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim . . . ." Accordingly, Applicant submits that the objection of claim 30 under 37 C.F.R. § 75(c) is improper and should be withdrawn.

Applicant also respectfully submits that pending claims 1-31, as originally filed, are patentable over the prior art cited. To reject a claim as obvious over a combination of the prior art references, there must exist some suggestion or motivation, either in the prior art itself or in the knowledge of one of ordinary skill in the art, to combine the references as provided. See, e.g., M.P.E.P. § 2143. The mere fact that the prior art references can so be combined, absent a motivation to do so, is insufficient. See, e.g., *id.* Moreover, it is improper to employ hindsight gleaned from the Applicant's invention to support an obviousness rejection. Accordingly, Applicant submits that there is no such motivation to combine the ballet slipper taught in the Dancewear 1999 reference with the toe box pointe shoe of Minden '069.

The dance shoe of the present invention is directed to providing a pointe shoe having increased flexibility between the toe and the heel. This is accomplished by providing a toe box point shoe having a split sole design. While the split sole design was known in the separate art of ballet slippers, the split sole design had not previously been incorporated into a pointe shoe for various reasons.

In re Appln. of BARUCK  
Application No. 10/033,987

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*Ballet slippers*

Ballet slippers and pointe shoes are functionally different shoes for distinct styles of dance. Ballet slippers are traditionally made of soft, flexible materials such as supple leather or canvas in order to conform to the dancer's foot so that the slipper appears to move along with bending and flexing of the foot. The pleated folds on the front of the shoe enable the dancer to feel the dance floor and gain stability. Ballet slippers typically feature a suede sole that allows the dancer's foot to slide across the dance floor while still providing traction to prevent slipping. As mentioned above, a known design of the sole of a ballet slipper is the split sole, in which the sole corresponds to only the ball and heel, and not the arch, of the dancer's foot.

Pointe dancing is an altogether distinct style and thereby requires a different style of shoe. In pointe dancing the dancers' dance upon the tips of their toes to further enhance the appearance of being suspended in air. To facilitate this, dancers at first would sew several stitches into the toes of their ballet slippers to make the slippers stiffer. Since doing this proved insufficient, the toe box pointe shoe evolved as a distinct piece of equipment providing proper support for dancing over extended period of time on the tips of the dancer's toes.

To provide the required support, the traditional point shoe includes a toe box often made of rigid material resulting in sufficient strength for standing on pointe. Also often included is a shank which is typically made from a stiff material and provides support to the arch of the dancer's foot such that a portion of the dancer's weight is transferred from her toes. The sole of a point shoe is also traditionally made from a stiff material and extends along the length of the bottom of the shoe for providing additional support. Pointe shoe soles are traditionally not soft and flexible.

Accordingly, where ballet slippers are designed of soft flexible materials to mold to and move with the dancer's foot, pointe shoes are made from rigid materials to provide the necessary support for dancing upon the tips of toes. Once the pointe shoes begin to soften and become flexible, they were no longer useful for traditional pointe dancing as they failed to provide the required support. Hence, while the split sole design facilitates the flexibility desirable in ballet slippers, that function was previously undesirable in pointe shoes. Therefore, there exists no motivation or suggestion to combine the split sole design known from ballet slippers with the traditional toe box pointe shoe.

Applicant further wishes to note disclosure of Minden '069, while recognizing a problem addressed in the present invention, seeks to solve this problem in a vastly different way. Specifically, Minden '069 recognizes that dancers often physically break-in new pointe shoes to increase their flexibility, but that doing so decreases the shoe's useful life. See, e.g.

In re Appln. of BARUCK  
Application No. 10/033,987

Col. 1, lines 29-40. This problem is resolved, as Minden '069 teaches, by providing a pointe shoe having an integral shank and toe box made of flexible thermoplastic material. See, e.g., Col. 2, lines 42-46. Accordingly, no motivation exists to incorporate the split sole design as disclosed in Dancewear 1999 with Minden '099 and thus independent claims 1 and 31 are patentable over these prior art references.

If a claim depends upon another claim that is not rendered obvious by a combination of prior art references, that dependent claim can likewise not be rendered obvious. See, e.g., *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Accordingly, Applicant submits that claims 2-30, which depend upon claim 1, are also not obvious over the cited prior art.

*Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



John M. Augustyn, Reg. No. 33,589  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

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